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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/896,874

06/29/2001

Lawrence Y. Fang

13615.40USU1

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04/03/2003

MCDONNELL BOEHNEN HULBERT & BERGHOFF
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EXAMINER

KUMAR, SHAILENDRA

ART UNIT

PAPER NUMBER

1621

12

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/896,874

Applicant(s)
Fang et al

Examiner
Shailendra Kumar

Art Unit
1621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 7, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13, 16-18, 21-24, and 27-148 is/are pending in the application.
- 4a) Of the above, claim(s) 31-143 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-13, 16-18, 21-24, 27-30, and 144-148 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9, 10 6) ☐ Other:

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DETAILED ACTION

This office action is in response to applicants' communication filed in paper # 11, on 2/7/03.

Claims 2-13, 16-18, 21-24, and 27-148 are pending in this application. Claims 1, 14-15, 19-20 and 25-26 have been canceled. Claims 31-143 stand withdrawn from the consideration, being drawn to the non elected invention.

1. Applicants' arguments with respect to the disclosure statement has been considered and were not found convincing. The disclosure statement has not been considered for the reasons as set forth in paper # 8. See the citation below.

The citations are ***Golden Valley Microwave Foods v. Weaver Popcorn Co.***, 24 USPQ 2d 1801, DC NInd 1992; ***Molins PLC v. Textron Inc.***, 33 USPQ 2d 1823 (CAFC 1995); and ***Penn Yan Boats v. Sea Lark Boats***, 178 USPQ 577 (5th Cir. 1973).

The following is an electronic reproduction of the USPQ record of the Molins CAFC decision:

Following this consultation, on September 21, 1984, Hirsh and Smith filed a document citing a great deal of prior art under 37

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C.F.R. Section 1.501 13 in the '563 patent file. The document was 11 pages in length and contained a listing of 23 U.S. patents, 27 foreign patents, and 44 U.S. and foreign printed publications. The citation was not accompanied by any comment or discussion concerning the relevancy of the patents and printed publications, nor were translations provided for most of the foreign patents and publications.

After the '563 patent was accepted for reexamination, Hirsh and Smith submitted a response to the first office action, requesting that the examiner consider and make of record all of the documents contained in the Rule 501 prior art citation. Hirsh and Smith provided English language equivalents or translations of the foreign documents and briefly commented as to the content of the cited art. They also cited the same prior art during prosecution of the '410 patent.

The court concluded that, by "burying" Wagenseil in a multitude of other references, Hirsh and Smith intentionally withheld it from the PTO because this manner of disclosure was tantamount to a failure to disclose. Citing *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1328, 178 USPQ 577 (5th Cir.), *cert. denied*, 414 U.S. 874 (1973), the court stated that Hirsh's and Smith's failure to highlight Wagenseil in light of their knowledge of Whitson's actions in the foreign prosecutions violated their duty of candor to the PTO. Citing our precedent, *Textron* asserts that Smith's and Hirsh's conduct is "inexcusable, fraudulent, and cannot operate to cure Whitson's inequitable conduct." See *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 220 USPQ 289 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (where intentional material misrepresentations have been made, a "cure" through voluntary efforts during prosecution must be demonstrated by clear, unequivocal, and convincing evidence).

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QUALE ACTION

This application is in condition for allowance except for the following formal matters:

Claims 31-143, drawn to the non elected invention, should be canceled.

Claims 2-13, 16-18, 21-24, 27-30, and 144-148 are allowed..


Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire TWO MONTHS from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703) 308-4519.

S.Kumar

April 2, 2003


SHAIENDRA KUMAR
PRIMARY EXAMINER
GROUP 1600